

REMARKS

Reconsideration of the application is respectfully requested on the grounds that U.S. Patent No. 6,636,247, relied upon to show the concept of blocking access to a website requested by a user, as claimed, is not "prior art."

The Applicant has previously established a conception date of before the filing date of the Hamzy patent (January 31, 2000). The attached supplemental declaration and exhibits now establishes diligence from before January 31, 2000 to the filing date of the present application, December 22, 2000.

The Applicant's activities during this time period are set forth in detail in the declaration and one of the attached exhibit files labeled "evidence_of_diligence.pdf," which is a flowchart prepared by the Applicant and referred to in the declaration which lists on a day-to-day basis the activities performed during this period and cross-references them to attached exhibit files. It is respectfully noted that some of the files referenced in the flowchart are attorney-client communications that have been withheld to preserve privilege. The privileged files are all from October to December, 2000, but there are other exhibits from this period that refer to the activities in question.

Basically, the declaration and attached Exhibits show that the Applicant spent the entire 11 months between January 31, 2000 and December 22, 2000 working on his invention, performing research on ways to reduce it to practice, and searching-for and engaging a U.S. patent attorney to prepare the patent application. From January 31 to July 1, 2000 the Applicant worked on this invention **every day** except for one and two day breaks for illness, exams, and a visit from his brother and fiancée. The **longest break** during the entire period was from July 2 to July 13, 2000, but that **two-week** break was an excusable break required for moving back to Greece from the Applicant's Graduate School in France. After July 13, the Applicant worked diligently on his invention every day except for a few weekend days.

The court cases clearly recognize that a few days off for illness, other activities, and vacations do not constitute inexcusable lack of diligence. For example, in the case *Reed and Wilkinson v. Tornqvist and Langer*, 168 USPQ 462, (CCPA 1971), the court held that a joint inventor's inactivity for **four weeks** was excusable where other inventor was unavailable for three weeks because of **vacation** and for a fourth week because of **unexpected illness of father**. This case is notable because the "joint inventor" was excused for doing nothing even though it was his co-inventor who was on vacation and had an ill father. In addition, three weeks was considered by the court to be a reasonable time to review the patent application draft prepared by the patent attorney.

In the present case, the Applicant never took more than two weeks off, the patent search took two weeks, the Applicant completed his review in five days, the patent application was complete in three weeks (which included one week of Thanksgiving vacation for the patent attorney), and the draft was reviewed and approved in one week, which was far less time than was needed by the U.S. inventors in the *Reed and Wilkinson* case, even though the Applicant was a graduate student living in France and then Greece rather than an employee of a company with a staff capable of assisting in the reduction-to-practice and patenting process.

Other court cases also suggest that the Applicant's daily activities as set forth in the attached declaration are more than sufficient to show diligence. For example, the case *Griffith v. Kanamaru*, 2 USPQ2d 1361, 1362 contains the following statements¹: "*A review of the caselaw on excuses for inactivity in reduction to practice reveals a common thread that courts may consider the reasonable everyday problems and limitation encountered by an inventor*"; "*exercise of reasonable diligence * * * [asterisks in original] does not require an inventor to devote his entire time thereto, or to abandon his ordinary means of livelihood*"; and "*where applicant made bona fide attempts to perfect his invention, applicant's poor health,*

¹ It is true that the ultimate conclusion in this case was lack of diligence, but the reason was that the inventor spent a year working on an "unrelated research project," as explained on page 1364. The court actually excused a delay of several months to procure funding, but the work on other projects was inexcusable. The present Applicant did not work on any other projects.

responsibility to feed his family, and daily job demands excused his delay in reducing his invention to practice).” These statements all support that conclusion that the Applicant was reasonably diligent in pursuing reduction to practice of his invention for the period from January 31, 2000 to December 22, 2000, as evidenced by the attached declaration and exhibits.

Since the Hamzy patent is the *only* reference of record that discloses the concept of blocking access to a website requested by the user, which is positively claimed, it is respectfully submitted that removal of the Hamzy patent as a prior art reference overcomes the rejection. The Auxier patent not only “*does not explicitly disclose preventing access to said website, and continuing to prevent said access to said website so long as the user fails to submit the appropriate reply,*” it does not *implicitly* disclose, or even have anything to do with, such blocking. To the contrary, Auxier is directed to an interactive banner advertisement that pops up when a user requests a website, and that sends the user to a third party website (*rather than the requested website*) when the user interacts with the advertisement. The user of Auxier’s system is free to access the requested website by simply not responding to the advertisement, and therefore cannot possibly be said to be blocked by the advertisement in the manner claimed. The remaining patents applied in the Official Action, all of which have been discussed in previous responses, also do not even remotely suggest the claimed blocking. Only the Hamzy patent discloses the presently claimed blocking, and the Hamzy patent is not prior art with respect to the present application.

It is respectfully submitted that since the Auxier patent did not prevent IBM from being granted a patent on website blocking, the Auxier patent should also not prevent the Applicant from being granted a patent for the same type of website blocking. Under the American system, the first to invent is entitled to a patent even though someone else might have filed first. The purpose of this rule is to level the playing fields so that companies like IBM that can file patents in a few days do not prevent individuals and small companies from benefitting from their earlier inventions.

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In summary, because the Hamzy patent has been overcome by a showing of earlier conception and diligence to filing of the application (constructive reduction to practice), it is respectfully submitted that each of the rejections under 35 USC §103(a) should be withdrawn and the application expeditiously passed to issue.

Respectfully submitted,

BACON & THOMAS, PLLC

A handwritten signature in black ink, appearing to read 'B. Urcia', with a long horizontal flourish extending to the right.

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